

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ALEXANDER LIFSON

Appeal No. 2001-1484
Application 09/092,368

ON BRIEF

Before COHEN, PATE, and NASE, Administrative Patent Judges.

PATE, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 through 7, 11 and 12. Claims 8 through 10 and 13 through 15 stand objected to but otherwise contain allowable subject matter. These are all the claims in the application.

The claimed invention is directed to an improvement in the compressor art in which a compressor is rotated in reverse for a limited time after start-up.

Appeal No. 2001-1484
Application 09/092,368

The claimed subject matter may be further understood with reference to the claims as they appear appended to the appeal brief.

The references cited by the examiner as evidence of obviousness are:

Smith	2,106,685	Jan. 25, 1938
Prenger et al. (Prenger)	5,076,067	Dec. 31, 1991

Claims 1 through 7, 11 and 12 stand rejected under 35 U.S.C. § 103 as unpatentable over Prenger in view of Smith.

BACKGROUND

This case was previously remanded to the examiner to construe claim 1 on appeal and make findings of facts with respect to the Smith patent. The examiner provided views as to the construction of claim 1 and findings of facts with regard to Smith. Appellant also submitted his views with respect to the remand. Thus, the case is up before us for decision on the rejection of claims.

OPINION

We have carefully reviewed the rejection on appeal in light of the arguments of the appellant and the examiner. As a result of this review, we have determined that the subject matter of claim 1 does not pass muster under 35 U.S.C. § 112, second

paragraph, and we cannot compare the claimed subject matter therein to the prior art in any meaningful way. Consequently, we reverse the rejection of claims 1-7, and enter a new rejection of claims 1-10 under 35 U.S.C. § 112, second paragraph, pursuant to our authority under 37 CFR § 1.196(b). Additionally, we reverse the prior art rejection of claims 11 and 12. A detailed explanation follows.

Our initial problem with the interpretation of claim 1 concerns how to construe the term "compression element" as it appears in the third line of claim 1. The specification does not use this language.

Additionally, we are unable to ascertain whether the functional language "which does not effectively compress fluid when rotated in one direction" as it appears in line 3 of claim 1 refers to the previously recited "pump unit" or the previously recited "compression element." We note that a movable scroll alone cannot compress fluid. Yet if the functional language refers to the compression element, the compression element is rotated--which the fixed scroll is not. Thus, we are unable to determine if "compression element" refers to the orbiting scroll alone or both the fixed and orbiting scrolls together. If the compression element refers to the structure that actually

compresses the working fluid, then for appellant's device, the compression element would appear to be fixed and orbiting scrolls 39 and 33, respectively. In the Smith device, the compression element of the pump and motor unit would apparently be the rotary compressor consisting of the housing, an eccentric 24, and a divider block 26 and perhaps discharge valve 32 which permits pressure to build up for compression.

Furthermore, in line 8, of claim 1 an additional step is recited as "beginning to rotate said motor and said pump unit" Presumably, only the rotatable part of the compression element and the motor rotor are rotated. It would appear from the second and third lines of the claim that "a motor and pump unit" therein recited includes some stationary structure that is not rotated.

Our problems with the construction of claim 1 in this regard are significant in that how "compression element" is construed has a bearing on whether Smith is anticipatory of the claim. We note that appellant and the examiner seem to agree that Smith, when rotated in a reverse direction, sweeps refrigerant out of the compressor and into the return conduit 56 at a pressure somewhat higher than the return conduit pressure. Smith does not disclose a valve in the return conduit 56. Thus, the sweeping

or clearing of the compressor appears to satisfy the claim language of "not effectively" compressing fluid when rotated in one direction. Also, we note that if the functional language "which does not effectively compress fluid when rotated in one direction" as it appears in line 3 of claim 1 refer to the previously recited pump unit as a whole with its entire structure such as a motor and valving, then it would appear that the claimed subject matter lacks novelty over Smith.

Some other problems with claims 1-10 are as follows: Clause (c) of claim 1 refers to "said first direction." No first direction has been recited. Presumably this should refer to "said one direction." Claim 2, line 1 refers to "said sealed compression shell." No sealed compression shell has been previously recited. Presumably, this refers to the sealed compressor shell of claim 1.

All words in a claim must be considered in judging the patentability of that claim against the prior art. If no reasonably definite meaning can be ascribed to certain terms in the claim, the subject matter does not become obvious--the claim becomes indefinite. *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Our analysis of the claims indicates that considerable speculation as to meaning of the terms employed and

assumptions as to the scope of such claims needs to be made. We do not think a rejection under 35 U.S.C. 103 should be based on such speculations and assumptions. *In re Steele*, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962); *Ex parte Head*, 214 USPQ 551 (Bd Pat App&Int 1981). Accordingly, we are reversing the rejection under section 103 and entering a new rejection under section 112, second paragraph. We must emphasize that this is a technical reversal only, in the sense that claim 1 is too indefinite for us to apply the prior art.

With regard to claims 11 and 12, we reverse the rejection of these claims. We are in agreement with appellant that scroll-type compressors are self unloading as appellant describes in the reply brief. Accordingly, there would have been no suggestion or motivation for one of ordinary skill in the compressor art to apply the teachings of Smith to the compressor of Prenger. The rationale of Smith of low starting torque is obviated by the scroll-type nature of Prenger.

Pursuant to our authority under 37 CFR § 1.196(b) we enter the following rejection:

Claims 1-10 are rejected under 35 U.S.C. § 112, second paragraph for the reasons discussed above.

SUMMARY

We have reversed the rejection of claims 1-7, 11 and 12. Pursuant to 37 CFR § 1.196(b) we have entered a new rejection of claims 1-10 under 35 U.S.C. § 112, second paragraph.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

Appeal No. 2001-1484
Application 09/092,368

No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

REVERSED 1.196(b)

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
WILLIAM F. PATE III)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
JEFFREY V. NASE)	
Administrative Patent Judge)	

WFP:pgg

Appeal No. 2001-1484
Application 09/092,368

Carlson, Gaskey & Olds, P.C.
400 West Maple, Suite 350
Birmingham, MI 48009